

REMARKS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

At the outset, regarding the renumbering of the claims, Applicants understand that the application was originally filed as the National Phase of PCT/GB99/02796 and included the same claims as were pending in the International Application at the time this application was filed. In this regard, while the originally filed International Application included claims 1-23, these claims were subsequently amended by adding claims 24 and 25, as shown in the attached copy of WO 00/11949, the publication of PCT/GB99/02796. It is believed that the papers originally filed with this application correctly showed that claims 1-25 were pending. Accordingly, it is believed that the numbering of the claims in the Amendment filed February 28, 2001, starting with claim 26, was correct. If so, the Examiner is kindly requested to renumber the pending claims as claims 26-51. For the present, however, the claims will be referred to as renumbered claims 24-49.

The Examiner urges that the application contains claims to more than one species of the generic invention including (1) the type of composition, e.g., surface cleaning, paint, etc.; and (2) active agent or biocide, e.g., isothiazolones.

For (1) Applicants elect paint or lacquer (renumbered claim 35). If further particularity is required Applicants elect paint. If still further particularity is required, Applicants elect water-based paint (renumbered claim 36).

For (2) Applicants elect isothiazolones as in (amended) renumbered claim 42 (original claim 44).

Since the elected species is acknowledged to be free of the prior art (and since there are no outstanding rejections under 35 USC 112 – as per the fourth paragraph on page 4 of the Action), renumbered claim 42 should be in condition for allowance and the search should be extended to include the remaining species of the generic renumbered claims 24-41, 43, 44, 48 and 49.

Applicants also respectfully submit that the requirements for election of species is improper and should be withdrawn. The pending claims do have a common technical feature. With regard to the compositional species (1), the common technical feature is porous inorganic carrier particles having biocide adsorbed thereon, as recited in renumbered claim 24, from which all other claims depend, directly or indirectly.

For the class of biocides (2), all of these species can be broadly characterized as Antimicrobial Agents (see the enclosed pages 191-194 from Kirk-Othmer's "Encyclopedia of Chemical Technology" Fourth Ed. Vol. 14).

For all of the above reasons examination of the entire scope of all of the generic claims is respectfully requested.

In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

Attached is a marked-up version of the changes made to the specification and claims by the current amendment. The attached Appendix is captioned "Version with markings to show changes made".

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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Attorney Reference: 018679/0277889  
Enclosures: Appendix  
Copy of WO 00/11949 Publication  
Kirk-Othmer reference

APPENDIX: VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

42. (as renumbered, original claim 44--twice amended) A method as claimed in claim 41 [as renumbered, original claim 43] in which the biocide is an [isothiazolone] isothiazolone.

*End of Appendix*